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6 UNITED STATES DISTRICT COURT  
7 WESTERN DISTRICT OF WASHINGTON AT SEATTLE

8 EKO BRANDS, LLC,

9 Plaintiff,

10 v.

11 ADRIAN RIVERA MAYNEZ  
12 ENTERPRISES, INC., and ADRIAN  
RIVERA, an individual,

13 Defendants.  
14

CASE NO. 2:15-cv-00522-JPD

ORDER ON OBVIOUSNESS  
REGARDING CLAIMS 5, 8, 18,  
AND 19 OF U.S. PATENT 8,720,320

15 The five-day jury trial of this matter concluded on Friday, June 8, 2018, with the jury  
16 reaching a unanimous verdict. Dkt. 242. One of plaintiff's contentions in this case was that  
17 claims 8 and 19 of defendants' U.S. Patent 8,720,320 ("Rivera 320 Patent") are invalid as  
18 obvious. *See* 35 U.S.C. § 103(a); *KSR Int'l Co. v. Teleflex, Inc. et al.*, 550 U.S. 398, 127 S.Ct.  
19 1727, 1729, 167 L.Ed.2d 705 (2007) (a patent is invalid if the "differences between the subject  
20 matter sought to be patented and the prior art are such that the subject matter as a whole would  
21 have been obvious at the time the invention was made to a person having ordinary skill in the  
22 art."). Prior to the trial, the question arose as to how the question of obviousness regarding  
23 claims 8 and 19 of the Rivera 320 Patent would be determined.  
24

1 During the Final Pretrial Conference, the Court asked the parties if they would agree to  
2 the Court resolving the obviousness question at the conclusion of the trial without posing  
3 specific questions to the jury on this issue, as the ultimate judgment of obviousness is a legal  
4 determination to be made by the Court in any event. *See KSR International*, 550 U.S. at 427.  
5 Plaintiff agreed that because obviousness is ultimately an issue of law to be decided by the  
6 Court, it was unnecessary to submit the underlying factual questions to the jury and indeed, it  
7 would simplify matters and avoid potential juror confusion if the Court resolved the  
8 obviousness question. Dkt. 216. If defendants insisted that the jury resolve the factual  
9 questions relevant to the obviousness issue, however, plaintiff's position was that the jury must  
10 reach a unanimous verdict as to each factual finding.

11 By contrast, defendants insisted that the Court had no role to play with respect to the  
12 factual questions underlying the obviousness inquiry, while conceding that the ultimate issue  
13 of obviousness is an issue of law. However, defendants did not propose any factual questions  
14 to be submitted to the jury, and instead thought the Court should simply pose the ultimate legal  
15 question of whether the River 320 patent is invalid as obvious to the jury. When Court advised  
16 defendants that the ultimate legal question would not be posed to the jury, defendants argued  
17 that each element as to which obviousness was challenged would require the jury to make a  
18 unanimous factual finding.<sup>1</sup>

19 After hearing the positions argued by the parties, the Court directed the parties to  
20 confer and prepare a special verdict form, which highlighted the portions of the elements as to  
21 which there was disagreement on the issue of obviousness. After some tinkering, both parties  
22 expressed satisfaction with the form of the special verdict. The parties also agreed on the

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24 <sup>1</sup> Defendants failed to submit any type of special verdict form consistent with their position.

1 definition of a person skilled in the art, and defendants confirmed that they had no evidence to  
2 present related to the “secondary considerations” regarding obviousness. No objections or  
3 exceptions were made by either party regarding the instructions to the jury on the factual  
4 questions regarding obviousness, or to the special verdict form. Similarly, no FRCP 50  
5 motions were made relating to the issue of obviousness of Claims 8 and 19 of the Rivera 320  
6 patent.

7 Evidence was presented to the jury on whether specific elements of Claims 8 and 19  
8 were obvious. Because these were dependent claims, the jury was also asked for factual  
9 findings on Claims 5 and 18, upon which Claims 8 and 19 depend. The jury returned a  
10 unanimous verdict that all of the allegedly inventive features in Claims 5, 8, 18 and 19 would  
11 have been obvious to a person skilled in the art. Dkt. 242.

12 The Court finds that substantial evidence supports the jury’s verdict, including the  
13 detailed testimony of plaintiff’s expert witness Dr. Howle, who the Court found to be highly  
14 credible. By contrast, the Court considered the testimony of defendants’ expert Mr. Philips, as  
15 well as ARM witnesses Mr. Rivera and Mr. Ditta, substantially less credible. The jury could  
16 reasonably afford the testimony of defendants’ witnesses less weight, and adopt Dr. Howle’s  
17 testimony as to the factual questions related to obviousness. Indeed, defendants conceded as  
18 much, based upon their declination to “fil[e] a brief on obviousness before the Court’s  
19 anticipated judgment on Friday, June 15, 2018.” Dkt. 245 at 1.

20 Accordingly, the Court declares as follows:

- 21 1. Claim 5 of U.S. Patent No. 8,720,320 (“Rivera 320 Patent”) is invalid as obvious to  
22 a person of ordinary skill in the art in light of each of the following references:
  - 23 a. U.S. Patent No. 3,878,722 (“Nordskog 772”)
  - 24 b. U.S. Patent No. 6,079,315 (“Beaulieu 315”)

1 c. Admitted Prior Art in the Rivera 320 Patent.

2 2. Claim 18 of the Rivera 320 Patent is invalid as obvious to a person of ordinary skill  
3 in the art in light of each of the following references:

4 a. Nordskog 772

5 b. Beaulieu 315

6 c. Admitted Prior Art in the Rivera 320 Patent.

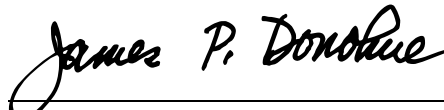
7 3. Claims 8 and 19 of the Rivera 320 Patent are invalid as obvious to a person of  
8 ordinary skill in the art, in light of each of the following references:

9 a. Nordskog 772 by itself, and in light of reason to combine it with Beaulieu  
10 315 and the Admitted Prior Art disclosed in the Rivera 320 Patent.

11 4. Claims 8 and 19 of the Rivera 320 Patent are invalid as obvious to a person of  
12 ordinary skill in the art in light of U.S. Patent No 6,658,989 (Sweeney 989), and in  
13 light of the fact that one with ordinary skill in the art would have had reason to  
14 combine Sweeney 989 with Nordskog 772, Beaulieu 315, and the Prior Art  
15 disclosed in the Rivera 320 Patent.

16 The Clerk is directed to send a copy of this Order to counsel for both parties.

17 DATED this 14th day of June, 2018.

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20 JAMES P. DONOHUE  
21 United States Magistrate Judge  
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